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REMARKS

Claims 1-30 are pending in the application and are being examined with respect to SEQ ID NO: 1. Claims 1, 9-14, 16, 17, 21 and 28 have been amended. Support for the amendments can be found in the specification as filed. No new matter has been added by way of amendment. Claims 2-8 have been cancelled. Reexamination and reconsideration of the claims are respectfully requested.

The Rejection of Claims Under 35 USC §112, First Paragraph, Should be Withdrawn *Written Description*

The Examiner has rejected claims 1-30 under 35 USC §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner further states that this is a new matter rejection because the phrase "less than 1000 base pairs in length" is not supported by the originally filed specification or claims.

Applicants presented a sequence listing in the originally filed application containing the sequence of SEQ ID NO: 1 as well as variant promoters based on SEQ ID NO: 1, all of which have their full sequences presented, and all of which are clearly less than 1000 base pairs in length. Accordingly, the recitation of "less than 1000 base pairs in length" is an inherent characteristic which is supported by the original filing. However, in an effort to further prosecution, Applicants have removed reference to the phrase of "less than 1000 base pairs in length."

The Examiner states (page 4) that "Applicants do not describe any polynucleotide promoter sequences that are 90%, 80% or 70% identical to SEQ ID NO: 1." The Examiner also states "Applicants further do not describe any polynucleotide promoter sequences that are at least 90% identical to 100 contiguous nucleotides in a nucleotide sequence of SEQ ID NO: 1, or to the promoter comprising at least 20

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contiguous nucleotides in the nucleotide sequence of SEQ ID NO: 1, and to the promoter comprising at least 40 contiguous nucleotides in a nucleotide sequence of SEQ ID NO: 1." The Examiner also states that the traversal of this argument in the previous response to Office Action was unpersuasive, because the genus described in the claimed invention, that of promoters isolated from the SVBV E3 genome, all derived from the single genomic clone of SVBV E3, is much narrower than 80% identity to SEQ ID NO: 1 over the entire length.

Applicants respectfully disagree with the Examiner's statement for the reasons of record given in the response to the Office Action of 31 August 2004. As previously stated, Applicants describe three promoter sequences (SEQ ID NOs: 2, 3 and 4) that are at least 90% identical to 100 contiguous nucleotides of SEQ ID NO: 1. Inherently, these same three promoter sequences are at least 90% identical to at least 20 and at least 40 contiguous nucleotides of SEQ ID NO: 1. Furthermore, these three promoter sequences would hybridize to SEQ ID NO: 1 under the conditions described in the specification. However, in the interests of furthering prosecution, Applicants have cancelled claims 2-8.

Enablement

The Examiner has rejected claims 1-4 and 6-30 under 35 USC §112, first paragraph because the specification, while being enabling for a nucleic acid comprising a promoter comprising SEQ ID NO: 1 does not reasonably provide enablement for the broad scope of the claims, for reasons of record set forth in the Office Action of 31 August, 2004.

As already presented in the instant response, Applicants have amended the claims to remove reference to the phrase "less than 1000 base pairs in length," and have cancelled claims 2-8. Accordingly, Applicants assert that the rejections to the claims under 35 USC §112, first paragraph, have been overcome. Applicants request that the rejection of claims 1-30 under 35 USC §112, first paragraph, for enablement and written description, be withdrawn.

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CONCLUSION

In view of the above amendments and remarks, Applicants submit that the rejections of the claims under 35 USC §112, first paragraph, have been overcome. Applicants respectfully submit that this application is now in condition for allowance. Early notice to this effect is solicited.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject Application, the Examiner is invited to call the undersigned.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-1852.

Respectfully submitted,



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